

REMARKS

In the *Final Office Action*, the Patent Office maintained the rejection of claims 17-20, 23-26, 31-36 and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,844,797 to *Johnson* in view of U.S. Patent No. 5,957,693 to *Panec*. The Patent Office also maintained the rejection of claims 28-30, 38 and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Panec* and further in view of U.S. Patent No. 5,651,678 to *Phillips*. In response, Applicant respectfully submits that the combination of *Johnson* with the other cited references do not establish a *prima facie* case of obviousness as to any of the pending claims 17-20, 23-26, 28-36 and 38-42. According to MPEP § 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

As presented in its response to the *Office Action* dated October 27, 2006, Applicant submits that no *prima facie* case of obviousness has been established as there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the *Johnson* reference or to combine the *Johnson* reference with *Panec* and/or *Phillips*. Moreover, Applicant respectfully submits that the prior art references fail to teach or suggest all of the claimed limitations.

Johnson is directed to a photograph album for a selected theme comprising pre-printed pictures or views and accompanying text "to provide the user with guidance and inspiration to

take a corresponding series of photographs on the same theme” (Abstract). The user’s photographs are substituted for the pre-printed pictures or views to provide “a structured album of photographs and appropriate accompanying text” (Abstract). In one embodiment, the photograph album is in the form of a guidebook appropriate to a geographic location, historic building or the like, with spaces to receive photographs taken by the user. The stated purpose is to “provide a personalized yet organized record of the visit” while providing “additional interest for third parties viewing the album in the way that a disorganized collection of individual photographs will not” (col. 1, lines 13-26). Thus, *Johnson* is directed only to a method of creating structured, organized and personalized photograph albums for a selected theme.

With respect to the secondary references, *Panec* is directed to a method for promoting reading in a novice reader using a book that includes a story with two texts, one written at a reading level appropriate for a skilled reader and the other written at a lower reading level appropriate for the novice reader. Thus, the method disclosed by *Panec* promotes reading by using a traditional, pre-assembled, non-personalized book.

Phillips teaches an educational aid and a method for using the system to teach students to read using sight-word vocabularies. The method relies on the student’s natural ability to recall information, such as simple songs, rhymes, and stories which are easily memorized (col. 5, lines 53-55). Thus, the method disclosed by *Phillips* promotes sight-word reading based on memorization.

In the *Final Office Action*, the Patent Office takes the position that, because the cited references relate to printed matter that is designed to be shared with another person, there is motivation to combine the cited references for the purpose of encouraging and facilitating a novice reader to learn to read by making the experience more interesting for the child.

In response, Applicant respectfully submits that the combination of *Johnson* with *Panec* and/or *Phillips* fails to establish a *prima facie* case of obviousness as to any of the pending claims 17-20, 23-26, 28-36 and 38-42 at least because there is no suggestion or motivation to modify *Johnson*, or to combine these references, either within the references themselves, or in the knowledge generally available to one of ordinary skill in the art. In particular, *Johnson* is directed only to a method for creating structured, organized and personalized photograph albums for a selected theme. *Johnson* explains that a third party who views the structured and organized photo album may show more interest as compared to viewing a disorganized collection of individual photographs. However, *Johnson* has nothing whatsoever to do with methods for teaching someone to read. Therefore, it would not have been obvious to modify the *Johnson* method of constructing a photograph album by including repetitive language for a pre-reader according to *Panec*, or by memorizing text on pages according to *Phillips*.

Similarly, *Panec* is directed only to a method for promoting reading in a novice reader using a traditional, pre-assembled and non-personalized book, and *Phillips* is directed only to a method for teaching a student to read using sight-word vocabularies, neither of which has anything to do with constructing a photograph album for a selected theme according to *Johnson*. Therefore, it would not have been obvious to modify the *Panec* or *Phillips* methods for teaching a person to read by incorporating elements from the *Johnson* method of constructing a photograph album. As such, Applicant submits that neither the references themselves, nor the knowledge generally available to one of ordinary skill in the art would suggest or provide motivation to combine elements of methods for constructing photograph albums as disclosed by *Johnson* with elements of methods for teaching someone to read as disclosed by *Panec* and/or *Phillips*.

Moreover, Applicant respectfully submits that the combination of *Johnson* with *Panec* and/or *Phillips* fails to establish a *prima facie* case of obviousness as to any of the pending claims 17-20, 23-26, 28-36 and 38-42 at least because the prior art references fail to teach or suggest all of the claimed limitations. In particular, with respect to independent claims 17 and 42, all of the cited references fail to teach or suggest a reader obtaining a repetitive language kit having a theme related to a planned shared experience between a reader and a pre-reader, the reader sharing the experience with the pre-reader, and memorializing the shared experience between the reader and the pre-reader. Instead, the *Johnson* reference discloses a method whereby a user obtains a photograph album with a theme, the user has an outing or experience related to the theme, the user memorializes his or her outing or experience with photographs, and the user later shares the assembled photograph album with a third party. Thus, *Johnson* fails to disclose the claimed “planned shared experience” or “shared experience” between a user (such as a reader) and a third party (such as a pre-reader). Likewise, neither *Panec* nor *Phillips* discloses that the methods and materials used for teaching a person to read have anything whatsoever to do with a theme related to a planned shared experience between the reader and the pre-reader, the reader sharing the experience with the pre-reader, or memorializing the shared experience between the reader and the pre-reader.

Similarly, with respect to independent claim 31, all of the cited references fail to teach or suggest obtaining a repetitive language kit having a theme related to a planned experience for a pre-reader or memorializing an actual experience of the pre-reader. Instead, the *Johnson* reference discloses a method whereby a user obtains a photograph album with a theme, the user has an outing or experience related to the theme, the user memorializes his or her outing or experience with photographs, and the user later shares the assembled photograph album with a

third party. Since a child pre-reader could not be the user who performs all of the above-listed steps in the *Johnson* method, Applicant submits that *Johnson* fails to disclose the claimed “planned experience for a pre-reader” or “actual experience of the pre-reader.” Likewise, neither *Panec* nor *Phillips* discloses that the methods and materials used for teaching a person to read have anything whatsoever to do with a theme related to a planned experience for a pre-reader or memorializing an actual experience of the pre-reader.

For all of the foregoing reasons, Applicant respectfully submits that pending claims 17-20, 23-26, 28-36 and 38-42 are patentably distinguishable over the art of record and are therefore in condition for allowance.

CONCLUSION

Consideration of the foregoing remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicant. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the *Final Office Action* dated April 18, 2007 has been fully addressed. If any fee is due as a result of the filing of this paper please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Plano, Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

CONLEY ROSE, P.C.

Date: JUNE 18, 2007

5700 Granite Parkway, Suite 330
Plano, Texas 75024
Telephone: (972) 731-2288
Facsimile: (972) 731-2289

Shannon Warren Bates
Shannon Warren Bates
Reg. No. 47,412

ATTORNEYS FOR APPLICANTS